



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------------|------------------------|
| 10/731,657 | 12/08/2003 | Srikanth Karimisetty | 021756-001900US | 4952 |
| 51206 7590 11/20/2007 TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834 | | | EXAMINER POWERS, WILLIAM S | |
| | | | ART UNIT 2134 | PAPER NUMBER |
| | | | MAIL DATE 11/20/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|--|--|--|--|
| <p align="center">Office Action Summary</p> | <p>Application No.</p> <p>10/731,657</p> | <p>Applicant(s)</p> <p>KARIMISSETTY ET AL.</p> | |
| | <p>Examiner</p> <p>William S. Powers</p> | <p>Art Unit</p> <p>2134</p> | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Examiner has stated the below column and line numbers as examples. All columns and line numbers in the reference and the figures are relevant material and Applicant should be taken the entire reference into consideration upon the reply to this Office Action.

Response to Arguments

2. Applicant's arguments filed 9/7/2007 have been fully considered but they are not persuasive.

3. As to Applicant's argument that, "the mere act of preparing a document in Slater that requires one or more digital signatures does not teach or suggest that user input is received as recited in claim 1 to define an event that, upon occurrence, generates an electronic record that requires an electronic signature" (Remarks, page 10, lines 1-3), the Examiner respectfully disagrees. Applicant is directed to column 4, lines 1-25 of the Slater patent, which details at least one example of an event, a land transaction, which is defined by an electronic document that is created by the user and requires at least one electronic signature. For at least the reasons stated above, the rejection to the claims is maintained.

4. As to Applicant's argument that, "[t]he data or content disclosed in Slater that is entered into the template is substantially different from the user input that defines one or

more fields stored in an electronic record as recited in claim 1" (Remarks, page 10, lines 11-13), the Examiner respectfully disagrees. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The Applicant alleges the art of record is "substantially different" from the claim language, but has failed to specifically point out the differences.

5. As to Applicant's argument that, "Slater does not teach that user input is received to define one or more fields stored in the electronic record and to generate a map that maps data from underlying database tables to at least some of the fields defined for the electronic record as recited in claim 1" (Remarks, lines 24-27), the Examiner respectfully disagrees. The Applicant is directed to column 7, lines 5-49, the profile verification module ensures that entries in the template correspond with requirements for those entries in all jurisdictions involved with the document. For at least the above reasons, the rejection of the claims is maintained.

6. As to Applicant's argument that, "Slater does not teach or suggest that the templates in Slater include one or more fields as recited in claim 1" (Remarks, page 11, lines 5-6), the Examiner respectfully disagrees. The templates of Slater have a least a content portion and a signature block portion and the Examiner sees those as equivalent to the "one or more fields" of the claim language. For at least the above reasons, the rejection of the claims is maintained.

7. As to Applicant's argument that, "the legal transaction in Slater is content which is substantially different from an event or the occurrence of an event as recited in claim 1" (Remarks, page 12, lines 11-12), the Examiner respectfully disagrees. It is not the content of the document that is the event; it is the recording of the legal transaction that generates the document requiring signatures that is the event. For at least the above reasons, the rejection of the claims is maintained.

Response to Amendment

Claim Objections

8. In light of Applicant's amendments, the previous objections to the claims have been withdrawn.

Claim Rejections - 35 USC § 112

9. In light of the Applicant's amendments, the previous 35 USC 112, 2nd rejections of claims 1-22 have been withdrawn.

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1, 9 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Applicant has added limitations to the independent claims that specific user input results in specific actions (e.g., "third user input to generate a map"). The Examiner can find no evidence in the Specification or the Drawings that link any specific user input with a specific action as detailed in the independent claims 1, 9 and 17.

Claim Rejections - 35 USC § 101

12. In light of Applicant's amendments, the 35 USC 101 rejections of claims 17-22 have been withdrawn.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 1-3, 5, 8, 9-11, 13, 16-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent no. 6,796,489 to Slater et al. (hereinafter Slater) in view of US Patent No. 6,807,633 to Pavlik.

As to claim 1 as best understood, Slater teaches:

- a. Receiving first user input to define an event that, upon occurrence, generates an electronic record that requires an electronic signature (a document

is prepared that requires one or more digital signatures) (Slater, column 7, lines 5-16).

b. Receiving second user input to define one or more fields stored in the electronic record (document is prepared by the user through inputting data and content into a template and determining the signatures needed for the document) (Slater, column 7, lines 5-49 and column 9, lines 50-63).

c. Receiving third user input to generate a map that maps data from the underlying database tables to at least some of the fields defined for the electronic record (using templates to store documents in databases and using optional verification module) (Slater, column 7, lines 5-49).

Slater does not expressly mention the physical layout of the document. However, in an analogous art, Pavlik teaches:

d. Receiving fourth user input to define a layout for displaying data in the electronic record on a computer display when an electronic signature for the data record is collected (user selects data items to be displayed in the document according to position and orientation within the document) (Pavlik, column 5, lines 43-53 and figure 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the electronic document scheme of Slater with the user defined layout of Pavlik in order to further customize the document template as illustrated in figures 2 and 3 of Pavlik.

Slater as modified further teaches:

- e. Receiving fifth user input to identify a signatory approver for the electronic record (document is signed by one or more persons indicated in the electronic document) (Slater, column 7, lines 15-17).
- f. In response to the occurrence of the event (a legal transaction that is to be recorded in a county office) (Slater, column 10, lines 51-55), generating the electronic record (a document is prepared that requires one or more digital signatures) (Slater, column 7, lines 5-14) and displaying the electronic record to the signatory approver according to the defined layout (Slater, column 6, lines 38-40 and Pavlik, column 5, lines 16-21).
- g. Receiving an electronic signature from the signatory approver (Slater, column 7, lines 15-25).
- h. Associating the electronic signature with the electronic record (signatures are verified to ensure that the electronic document is in a suitable state of compliance to be saved) (Slater, column 8, lines 30-33).

As to claim 2 as best understood, Slater as modified teaches verifying the electronic signature prior to associating the electronic signature with the electronic record (signatures are verified to ensure that the electronic document is in a suitable state of compliance to be saved) (Slater, column 8, lines 30-33).

As to claim 3 as best understood, Slater as modified teaches associating the electronic signature with the electronic record comprises associating the electronic

signature with the electronic record in response to a positive verification of the electronic signature (signatures are verified to ensure that the electronic document is in a suitable state of compliance to be saved) (Slater, column 8, lines 30-33).

As to claim 5 as best understood, Slater as modified teaches verifying the electronic signature and storing the electronic record in a common repository of electronic records that are generated from multiple data sources (once the recorder as verified the signatures the electronic document is stored in a database) (Slater, column 15, lines 17-32 and figure 5).

As to claim 8 as best understood, Slater as modified teaches determining that an electronic signature is required, displaying data from the electronic record on a computer display (According to claim 1, only electronic documents that require electronic signatures are generated so that any document generated by the invention requires a digital signature. The document is presented to each of the one or more signatories so that their respective digital signatures can be captured) (Slater, column 7, lines 14-25).

As to claim 9 as best understood, Slater as modified teaches:

- a. A processor (Slater, column 5, lines 59-67).
- b. A database (Slater, column 15, lines 17-32).

- c. A computer-readable memory coupled to the processor, the computer readable memory configured to store a computer program (Slater, column 6, lines 25-28).

The limitations (i)-(viii) are substantially similar to the limitations of claim 1 and are similarly rejected.

As to claim 10 as best understood, the limitations of the claim are substantially similar to the limitations of claim 2 and are similarly rejected.

As to claim 11 as best understood, the limitations of the claim are substantially similar to the limitations of claim 3 and are similarly rejected.

As to claim 13 as best understood, the limitations of the claim are substantially similar to the limitations of claim 5 and are similarly rejected.

As to claim 16 as best understood, the limitations of the claim are substantially similar to the limitations of claim 8 and are similarly rejected.

As to claim 17 as best understood, the limitations of the claim are a computer program product comprising the method steps of claim 1 and are similarly rejected.

As to claim 18 as best understood, the limitations of the claim are a computer program product comprising the method steps of claim 2 and are similarly rejected.

As to claim 20 as best understood, the limitations of the claim are a computer program product comprising the method steps of claim 5 and are similarly rejected.

17. Claim 4 and claim 12 and claim 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent no. 6,796,489 to Slater et al. (hereinafter Slater) in view of US Patent No. 6,807,633 to Pavlik as applied to claim 1 and claim 9 and claim 18 respectively above, and further in view of US Patent No. 5,434,917 to Naccache et al. (hereinafter Naccache).

As to claim 4 as best understood, Slater as modified does not expressly mention that the digital signature comprises a user id and a password. However, in an analogous art, Naccache teaches the electronic signature comprises a user id and a password (a digital signature scheme that incorporates a user id and password into the computation of a digital signature) (Naccache, column 3, lines 1-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the electronic document scheme of Slater as modified with the digital signature computation of Naccache in order to establish the identity of user as suggested by Naccache (Naccache, column 3, lines 12-14).

As to claim 12 as best understood, the limitations of the claim are substantially similar to the limitations of claim 4 and are similarly rejected.

As to claim 19 as best understood, the limitations of the claim are substantially similar to the limitations of claim 4 and are similarly rejected.

18. Claims 6 and 7 and claims 14 and 15 and claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent no. 6,796,489 to Slater et al. (hereinafter Slater) in view of US Patent No. 6,807,633 to Pavlik as applied to claim 5 and claim 13 and claim 20 above, and further in view of US Patent No. 6,584,459 to Chang et al. (hereinafter Chang).

As to claim 6 as best understood, Slater as modified does not expressly mention using character large object format. However, in an analogous art, Chang teaches the electronic record comprises unstructured data in a character large object (CLOB) format (storing XML documents in CLOB format) (Chang, column 10, lines 49-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the electronic document scheme of Slater as modified with the CLOB format storage scheme of Chang in order to store long XML documents as suggested Chang (Chang, column 10, lines 49-62).

As to claim 7 as best understood, Slater as modified teaches the common repository is a database and wherein the unstructured data is a well-formed XML document stored within a column of a table stored in the database (storage scheme for XML documents in a database) (Chang, column 14, lines 31-35).

As to claim 14 as best understood, the limitations of the claim are substantially similar to the limitations of claim 6 and are similarly rejected.

As to claim 15 as best understood, the limitations of the claim are substantially similar to the limitations of claim 7 and are similarly rejected.

As to claim 21 as best understood, the limitations of the claim are a computer program product comprising the method steps of claim 6 and are similarly rejected.

As to claim 22 as best understood, the limitations of the claim are a computer program product comprising the method steps of claim 7 and are similarly rejected.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William S. Powers whose telephone number is 751 272 8573. The examiner can normally be reached on m-f 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on 571 272 3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/731,657
Art Unit: 2134

Page 15

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William S. Powers
Examiner
Art Unit 2134

11/13/2007



KAMBIZ ZAND
SUPERVISORY PATENT EXAMINER